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RECORD OF ORAL HEARING  
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte TIMOTHY HUGH NORMAN

Appeal 2008-2198  
Application 10/018,538  
Technology Center 2800

Oral Hearing Held: Thursday, August 14, 2008

Before BRADLEY R. GARRIS, CHUNG K. PAK, PETER F. KRATZ,  
Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

DONALD C. LUCAS, ESQ.  
Lucas & Mercanti, LLP  
475 Park Avenue South, 15th Floor  
New York, New York 10016

1           The above-entitled matter came on for hearing on Thursday,  
2   August 14, 2008, commencing at 1:28 p.m., at the U.S. Patent and  
3   Trademark Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia,  
4   before Jennifer M. O'Connor, Notary Public.

5           THE CLERK: Calendar number 30, Mr. Lucas.

6           JUDGE GARRIS: Good afternoon, Mr. Lucas. As you know,  
7   sir, you have about 20 minutes. Please begin.

8           MR. LUCAS: Thank you. Well, good afternoon. The  
9   invention that we're dealing with relates to a mirror -- rear-view mirror for  
10  an automobile or a vehicle, and the problem that was in the art was -- or that  
11  the inventor was facing is that the mirrors that got broken were hard to  
12  replace. I think we've all experienced if you have your outside mirror of  
13  your vehicle broken you often have to take it to a glass manufacturer to put a  
14  -- to a glue a piece on. So they wanted to make it easy to replace.

15          The other problem they were having was that people would  
16  steal the glass, and generally that's done by prying the glass away from the  
17  frame. So he wanted to make it easy to replace and he wanted to make it so  
18  it was difficult to remove for vandalism.

19          And the problem was occurring -- actually this is a British  
20  company that is the assignee here. They were having problems with a bus  
21  company and the bus drivers were breaking the mirrors so they couldn't take  
22  the bus on the road and they didn't have to work. So the solution they came  
23  up with was they took the frame -- they took the lens, put in the frame and  
24  made it so that it snap-fitted in the housing, and that made it easy to replace.

1 So if the lens itself got broken, it was very easy to remove the frame and  
2 snap-fit another one right into the housing.

3 The other thing that they did was to make it hard to remove.  
4 They made it so that the frame and the lens was, as used in the claim, wholly  
5 within the housing so that neither the mirror nor the mirror lens nor the  
6 frame extended beyond the rim portion of the housing. The limitation about  
7 the frame and lens not extending, being wholly within the housing and not  
8 extending beyond the rim portion, was specifically added to distinguish over  
9 Lang fairly early on during prosecution. Lang does not teach that his frame  
10 and his lens are wholly within and do not extend beyond the rim portion.

11 There's a portion in Lang that talks about that it is -- that it does  
12 not extend latitudinally, but longitudinally. If you look at the drawings, it  
13 extends beyond. In fact, that's one of the features of Lang. He wants it to  
14 extend beyond. He has a ridge or a groove in his design. I think it's labeled  
15 20 -- labeled 23 or 130 -- reference character 23, reference character 131.  
16 And that groove is specifically there to prevent soiling of the mirror.

17 The secondary reference of Repay, which is used by the  
18 examiner, that shows an adjustable mirror with a frame, with a lens, and the  
19 frame is inside the housing. The examiner then -- the examiner used Repay  
20 because the teaching of the lens and the frame are inside. In order to  
21 respond to the examiner's use of Repay, what we did is we amended the  
22 claim specifically to say that it was fixed so that the frame and the lens are  
23 fixed within the housing.

24 We had a good deal of argument back and forth between  
25 ourselves and the examiner concerning the concept of fixed. There's a

1 portion from a dictionary that we filed to show that fixed means basically  
2 non-adjustable. In fact, during prosecution, one of the things we did is we  
3 added the word "non-adjustable," to which the examiner objected to and we  
4 removed it. But the idea of adding it was to emphasize the fact that fixed  
5 means it's non-adjustable.

6 Because we felt that the idea with Repay being an adjustable  
7 mirror, the most obvious difference between our invention and Repay was  
8 the concept of being fixed versus adjustable.

9 JUDGE PAK: Counsel, I noticed that the specification does not  
10 have specifics for the language, the frame and the mirror lens being wholly  
11 within the housing. Is this a limitation derived from the drawings?

12 MR. LUCAS: Yes, sir. It's from the drawings.

13 JUDGE PAK: So it's not part of the original disclosure other  
14 than for this illustration in the drawings?

15 MR. LUCAS: I would say it's part of the original disclosure  
16 because it is in the drawings, and that -- in fact, that was one of the issues I  
17 discussed with the examiner, the first examiner in this case, when we added  
18 that limitation. We discussed our drawings and that examiner felt that we  
19 did have adequate support. But that issue was addressed during prosecution.

20 JUDGE PAK: Does the specification indicate that this  
21 limitation is used to, as you put it, prevent the theft of some sort?

22 MR. LUCAS: In the last paragraph of the published  
23 application, and I guess the application itself, it talks about using a special  
24 tool to remove the frame and the mirror from the housing. So that's as far as  
25 going for the theft issue.

1                   But the combination, if we follow through, I feel, with the  
2 examiner's concept of the combination of Lang and Repay, if we replace  
3 Lang's lens and frame with Repay's lens and frame, we still don't end up with  
4 the invention, because we'd no longer have the snap-fit of the frame to the  
5 housing, because Repay, he attaches his frame and his lens to the back of the  
6 housing, the other thing, so that there's no snap-fit.

7                   And then the secondary portion that we feel is not there is the  
8 concept of being fixed, and that's -- that's an issue that the examiner and I  
9 have gone back and forth on, he taking the position that fixed is in Repay  
10 because Repay has an arm that goes out to dampen vibrations of the mirror,  
11 and therefore, it's a fixed; our argument being we're non-adjustable. Repay's  
12 adjustable. We're fixed, and what we mean by fixed is non-adjustable.

13                  So even if you -- if you were to take the examiner's position,  
14 still believe that we are patentable over the replacing Lang's lens and frame  
15 with Replay, because you still don't get the snap-fit between the frame and  
16 the housing.

17                  The other way that I thought I could look at the examiner's  
18 combination is simply if we use the concept of Repay, that being his frame  
19 and his lens inside the housing, and apply that to Lang. Then I -- then my  
20 position is, well then there's too many modifications that you have to do to  
21 Lang, because first you have Lang specifically teaching that his frame and  
22 his lens are outside the housing.

23                  If you look at the drawings in Lang, you would have to shrink  
24 both his frame and his lens to get them inside the housing. Then you would  
25 have to modify his snap-fit arrangement also to make it work so that when

1 you push or insert the frame and the lens inside the housing, that the snap-fit  
2 would still work. So I put to you that those two modifications are too much  
3 for an obviousness test.

4 Then third point about using Lang's -- correction, Repay's idea  
5 in Lang, is that Lang specifically teaches away from that combination or that  
6 idea. Lang teaches -- as I mentioned earlier, he's got grooves on the outside.  
7 It's reference character, as I said, 23, 131, which are intended to prevent  
8 soiling, is his term, of the lens.

9 So Lang, in my opinion, is specifically teaching that you want  
10 his arrangement where the frame and the lens are outside the housing, not  
11 inside the housing, because you want that ridge there. So I'm taking the  
12 position that Lang teaches away from the modification proposed by the  
13 examiner.

14 So then basically in conclusion, my position is that if you add  
15 Repay to Lang, even if we take the examiner's position that that would end  
16 up in a fixed arrangement, you still don't get the snap-fit of the frame to the  
17 housing, and Lang teaches away from using his concept of inserting the  
18 frame and the lens into the housing, and therefore, one of skill in the art  
19 would not make such a modification. Thank you.

20 JUDGE PAK: No questions.

21 JUDGE KRATZ: No further questions.

22 JUDGE GARRIS: No questions? Mr. Lucas, thank you very  
23 much, sir.

24 MR. LUCAS: Thank you.

25 Whereupon, at 1:39 p.m., the proceedings were concluded.